

## REMARKS

These remarks address the office communication mailed by the Examining Attorney, Layla G. Lauchman, on August 13, 2003.

The Examining Attorney provisionally rejected claims 3, 4, 6-8 of Application Serial No. 09/653,130 (the "'130 Application") under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of co-pending Application No. 09/578,058 (the "'058 Application").

The Examining Attorney informed that a timely filed terminal disclaimer in compliance with 37 CFR § 1.321(c) can be used to overcome the provisional rejection of the '130 Application based on a non-statutory double patenting ground provided the conflicting application or patent (the '058 Application) is shown to be commonly owned with the '130 Application.

Thus, in accordance with both 37 CFR § 1.321(c) and the Examining Attorney's statements contained in the August 13, 2003 office action, the assignee of record, Eight Star Diamond Company, Inc., herewith submits the following forms:

- A Terminal Disclaimer to Obviate a Provisional Double Patenting Rejection over a Pending Second Application form;
- A "Statement under 37 CFR § 3.73(b)" form showing EightStar Diamond Company, Inc.'s ownership of the '130 Application; and
- A "Statement under 37 CFR § 3.73(b)" form showing EightStar Diamond Company, Inc.'s ownership of the '058 Application.

The assignee of record has filed a terminal disclaimer in accordance with 37 CFR § 1.321 (c). The assignee has also shown that the '058 Application and the '130 Application are commonly owned. The assignee respectfully submits that the submission of these forms clearly

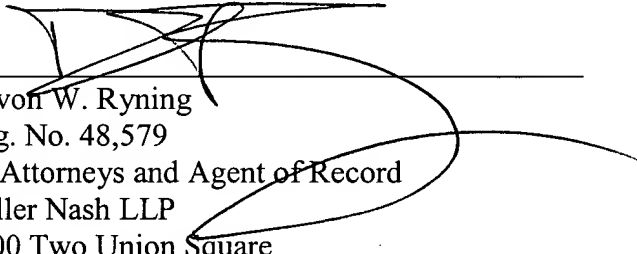
overcomes the Examining Attorney's provisional rejection of the '130 Application based on the grounds of non-statutory double patenting.

### **CONCLUSION**

Based on the above remarks, the assignee of record respectfully submits that it has overcome the provisional rejection of Application Serial No. 09/653,130 set forth by the Examining Attorney in her August 13, 2003 office action. The assignee earnestly solicits an early Notice of Allowance.

Please charge Deposit Account No. 13-3571 for any additional fees which may be required.

Respectfully submitted,



Devon W. Ryning  
Reg. No. 48,579  
Of Attorneys and Agent of Record  
Miller Nash LLP  
4400 Two Union Square  
601 Union Street  
Seattle, WA 98101  
Tel: (206) 622-8484